

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF NORTH CAROLINA
CHARLOTTE DIVISION
DOCKET NO. 3:20-MC-00136-RJC-DSC**

DENTSPLY SIRONA INC.,)
)
Petitioner,)
)
v.)
)
ALIGN TECHNOLOGY INC.,)
)
Respondent.)

ORDER

THIS MATTER is before the Court on Petitioner “Dentsply Sirona, Inc.’s Motion to Quash Align Technology, Inc.’s Subpoena to Produce Documents and Subpoena to Testify” (document # 1) filed September 3, 2020.

3Shape A/S and Align Technology are currently involved in a patent infringement case pending in the United States District Court for the District of Delaware, Case No. 18-cv-0886. In that case Align is accused of infringing U.S. Patent Nos. 9,629,551 and 10,349,042 by making, using, offering to sell, and/or selling Align’s accused iTero intraoral scanners.

On August 20, 2020, Align served non-party Dentsply Sirona with a Subpoena to Testify and a Subpoena to Produce Documents, Information or Objects in Charlotte, North Carolina. The Subpoenas directed Dentsply Sirona to produce a 30(b)(6) witness and documents related to eight topics by September 4, 2020. Dentsply Sirona filed this Motion to Quash.

Subpoenas issued to a non-party are governed by Federal Rule of Civil Procedure 45. Fed. R. Civ. P. 45; see Fed. R. Civ. P. 34(c) (“As provided in Rule 45, a nonparty may be compelled to

produce documents and tangible things or to permit an inspection.”). Although a subpoena must be issued by the court where the underlying action is pending under Rule 45(a)(2), challenges to the subpoena are to be heard by the district court where compliance with the subpoena was sought. In re Bayer Cropscience, No. 5:16-MC-10-RJ, 2016 WL 7429201, at *2 (E.D.N.C. June 14, 2016). The court where compliance is sought may transfer a motion to the issuing court if the person subject to the subpoena consents, or if the court finds that there are “exceptional circumstances” warranting transfer. Fed. R. Civ. P. 45(f); Ellis v. Arrowood Indem. Co., No. 2:14-MC-00146, 2014 WL 4365273, at *2 (S.D. W. Va. Sept. 2, 2014).

In evaluating whether “exceptional circumstances” are present, the court considers a number of factors related to the underlying litigation. These factors include the complexity, procedural posture, duration of pendency, and the nature of the issues pending before, or already resolved by the issuing court in the underlying litigation. See, e.g., XY, LLC v. Trans Ova Genetics, L.C., 307 F.R.D. 10 (D.D.C. 2014) (finding exceptional circumstances where issuing court “has already supervised substantial discovery and begun preparations for trial”); Judicial Watch, Inc. v. Valle Del Sol, Inc., 307 F.R.D. 30, 34 (D.D.C. 2014) (noting that the court should consider the complexity, procedural posture, duration of pendency, and the nature of the issues pending before, or already resolved by the issuing court in the underlying litigation when determining whether exceptional circumstances are present in a case); Wultz v. Bank of China, Ltd., 304 F.R.D. 38 (D.D.C. 2014) (transferring subpoena-related motions in “highly complex” litigation where issuing court “is in better position to rule ... due to her familiarity with the full scope of issues involved as well as any implications the resolution of the motion will have on the underlying litigation” and to further “the interest in obtaining consistent rulings on the issues presented”).

This Court has reviewed the filings in this action as well as the docket in the underlying Delaware action, which involves complex patent law claims and defenses. In light of the complexity and nuanced nature of the underlying case, the Court concludes that there are exceptional circumstances in this case warranting transfer to the District Court in Delaware. In particular, judicial economy, efficient case management, and the administration of justice are best served by transfer to Delaware.

IT IS THEREFORE ORDERED that “Dentsply Sirona, Inc.’s Motion to Quash Align Technology, Inc.’s Subpoena to Produce Documents and Subpoena to Testify” (document # 1) shall be TRANSFERRED to the United States District Court for the District of Delaware for consideration in the related action before that Court – 3 Shape A/S v. Align Technology, Inc., 1:18-cv-886-LHS.

The Clerk is directed to send copies of this Order to counsel for the parties and to the Honorable Robert J. Conrad, Jr.

SO ORDERED.

Signed: October 29, 2020



David S. Cayer
United States Magistrate Judge
